UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/852,497 | 05/10/2001 | Todd W. L. Vigil | 4022-4001US1 | 6397 |

27123 7590 03/25/2003

MORGAN & FINNEGAN, L.L.P.
345 PARK AVENUE
NEW YORK, NY 10154

| EXAMINER |
|---|
| YOUNG, JOHN L |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3622 | |

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 09/852,497 | Vigil et al. |
| **Examiner** | **Art Unit** |
| John Young | 3622 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *Jan 14, 2003* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-77* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-77* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

# REJECTION

## DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

## CLAIM REJECTION—35 U.S.C. §112

2. **REJECTIONS WITHDRAWN.**

## CLAIM REJECTIONS — 35 U.S.C. §103( a )

3. **REJECTIONS MAINTAINED.**

## CLAIM REJECTIONS—35 USC §101 Statutory Type Double Patenting(Same Invention)

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process . . . may obtain a patent therefor . . ." (Emphasis added). Thus, the term "same invention," in this context, means an invention

drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a statutory (same invention)double patenting rejection based upon 35 U.S.C. 101.

Claim 1 of application 09/852,497 is rejected under 35 USC §101 for same invention type double patenting for claiming the same invention as application 09/568,292.

4. For example:

Claim 1 Vigil et al. application 09/568,292:

1. A method of advertising to a viewer wherein by viewing an advertisement a viewer may qualify to win a prize, comprising:

transmitting an advertisement to a viewer;

transmitting to the viewer an offer to submit an entry to win a prize in response to the advertisement wherein the viewer is offered the opportunity to submit the entry only after the advertisement has been displayed to the viewer for a period of time;

receiving an entry for the prize from the viewer; and

selecting an entry as a winning entry to receive a prize.

Claim 1 Vigil et al. application 09/852,497:

1. A system of advertising to a viewer wherein by viewing an advertisement a viewer may qualify to win a prize, comprising:

transmitting an advertisement to a viewer;

transmitting to the viewer an offer to submit an entry to win a prize in response to the advertisement wherein the viewer is offered the opportunity to submit the entry only after the advertisement has been displayed to the viewer for a period of time;

receiving an entry for the prize from the viewer; and

selecting an entry as a winning entry to receive a prize.

**CLAIM REJECTIONS — 35 U.S.C. §103( a )**

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

5. Claims 1-77 are rejected under 35 U.S.C. §103( a ) as being obvious over Small 5,791,991 (8/11/1998) (herein referred to as "Small") in view of De Rafael 6,529,878 (03/04/2003) [US f/d: 03/19/1999] (herein referred to as "De Rafael").

As per independent claim 1, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 1.

Small lacks an explicit recitation of the "the advertisement has been displayed to the viewer for a period of time. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the

teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 2, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 2.

Small lacks an explicit recitation of the "the advertisement has been displayed to the viewer for a period of time. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill

in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 3, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 3.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 2, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 4-21, Small in view of De Rafael shows the system of claim 3 and subsequent base claims depending from claim 3. (See the rejection of claim 3 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 4-21.

Small lacks an explicit recitation of the elements and limitations of claims 4-21, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 4-21 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 22, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 22.

Small lacks an explicit recitation of the "the advertisement has been displayed to the viewer for a period of time. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 23, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 23.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 23, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 24-40, Small in view of De Rafael shows the system of claim 23 and subsequent base claims depending from claim 23. (See the rejection of claim 23 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 24-40.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 24-40, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 24-40 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 41, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 41.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 41, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 42-59, Small in view of De Rafael shows the system of claim 41 and subsequent base claims depending from claim 41. (See the rejection of claim 41 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 42-59.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 42-59, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 42-59 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 60, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 60.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 60, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 61 Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 61.

Small lacks an explicit recitation of the advertisement viewing time elements and limitations of claim 61, even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col.

1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 62-72, Small in view of De Rafael shows the system of claim 61 and subsequent base claims depending from claim 61. (See the rejection of claim 61 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25)

in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 62-72.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 62-72, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 62-72 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 73, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 73.

Small lacks an explicit recitation of the "the advertisement being displayed for a time period. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll.

19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per independent claim 74, Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) shows elements that suggest the elements and limitations of claim 74.

Small lacks an explicit recitation of the "the advertisement has been displayed to the viewer for a period of time. . . ." even though Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) suggests same.

De Rafael (col. 7, ll. 47-62) discloses "users . . . who viewed a certain advertisement . . . within a certain time. . . ."

De Rafael proposes advertisement viewing time modifications that would have applied to the teachings of Small. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of De Rafael with the teachings of Small because such combination would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claim 75, Small in view of De Rafael shows the system of claim 66. (See the rejection of claim 66 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claim 75.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 75, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 75 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

As per claims 76-77, Small in view of De Rafael shows the system of claims 1-75 and subsequent base claims depending from claims 1-75. (See the rejection of claims 1-75 supra).

Small (the ABSTRACT; FIG. 1 through FIG. 8; col. 1, ll. 19-35; col. 2, ll. 37-67; col. 3, ll. 1-50; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25) in view of De Rafael (col. 7, ll. 47-62) shows elements that suggest the elements and limitations of claims 76-77.

Small lacks an explicit recitation of the viewing time elements and limitations of claims 76-77, even though Small in view of De Rafael suggests same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 76-77 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means of *"targeting . . . advertisements and responding to consumer preferences. . . ."* (see De Rafael (col. 3, ll. 40-45) and would have provided means for *"an improved consumer product promotion method. . . . which provides for effective product promotion with minimal expense, and which results in improved efficiency for participating consumer product manufacturers and enhanced interest for consumers."* (see Small (col. 3, ll. 50-67; and col. 4, ll. 10-15)).

## RESPONSE TO ARGUMENTS

6. Applicant's arguments (Amendment A, paper#13, filed 01/14/2003) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons:

Applicant's arguments with respect to claims 1-77 have been considered but are moot in view of the new ground(s) of rejection introduced by the Examiner in the instant Office Action.

As per dependent claims 4-21, 24-40, 42-59, 62-72, 75 and 76-77, Applicant failed to seasonably challenge the Official Notice evidence of the prior Office Action.

It was well settled that "If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, Applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." (See MPEP 2144.03).

In this case, Applicant's response is silent as to a demand for references and a rebuttal of the Officially Noticed well known statement evidence presented in the prior Office Action; therefore, said Official Notice evidence is deemed admitted, and no further references are required in support of said Official Notice evidence.

The 35 USC 112, second paragraph rejections of claims 3-5, 9, 23-25, 29, 41-43 and 47 have been withdrawn, even though Applicant's arguments (Amendment A,

paper#13, filed 01/14/2003, p. 2, ll. 6-16) concerning the 35 USC 112, second paragraph rejections of said claims admit that said claims recite only a lower limit, without an upper limit. This Office Action acknowledges that "Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).... If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate." (See MPEP 2173.04). In this case, the claims at issue are too broad and read on the prior art because of said undue breadth; see the 35 U.S.C. 103 rejections supra.

Applicant's arguments (Amendment A, paper#13, p. 2, ll. 17-22; and pp. 3-8) allege "that a prima facie case of obviousness has not been made and that Claims 1-77 would not have been obvious over Small because Small does not teach or suggest the ... limitations, nor were they well known and expected in the art at the time of the invention...." This allegation has been carefully reviewed; however, Applicant's arguments are moot because of new grounds of rejection based on Small in view of De Rafael introduced in the instant Office Action.

Applicant's arguments (Amendment A, paper#13, p. 4, ll. 20-21, and p. 5, ll. 1-6) assert that "the International Preliminary Examination Report (IPER) from the corresponding PCT application.... found claims 1-77 of Applicants' invention to be

novel. . . ."; however, Applicant provides not support for said assertion. Therefore, Applicant's arguments are not persuasive.

Applicant's arguments (Amendment A, paper#13, p. 5, ll. 7-19, p. 6, p. 7, and p. 8) suggest that "the Small patent does not teach or suggest. . . ." the elements and limitations of the instant invention. However, this is not the case.

It is well settled in the law that the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); furthermore,

It is well settled in the law that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); also,

It is well settled in the law that "It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . ." (See MPEP 2144

RATIONALE DIFFERENT FROM APPLICANT'S IS PERMISSIBLE (August 2001) p. 2100-127.

In this case, and throughout the prior Office Action the obviousness rejections (including the admitted Official Notice evidence concerning the dependent claims) have relied upon the knowledge generally available to one of ordinary skill in the art and the prior Office Action (notwithstanding the Official Notice evidence concerning the dependent claims) has detailed with particularity in the independent claims where the features of claims are suggested in the prior art references and where there are teachings in the references to modify and/or combine the references to derive the present invention.

**CONCLUSION**

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The Examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Patent Examiner

(Temporary Full Signatory Authority)

March 14, 2003